

Application No.: 10/009353

Case No.: 55728US002

Remarks

Claims 13, 18, and 22 have been canceled. Claims 1-12, 14, 15, and 23-26 have been withdrawn from consideration. Claims 1-12, 14-17, 19-21, and 23-26 are pending.

Applicants gratefully acknowledge the withdrawal of the rejection of claims 16, 17, 19 and 21 under 35 USC 102(b). (Paper No. 21, ¶ 6.)

§ 103 Rejections

Claims 16, 17, 19 and 21 stand rejected under 35 USC § 103(a) as being unpatentable over Dawes (US 4,485,062). The Patent Office references the prior Office Action dated March 18, 2001, office action item 6. Applicant believes the Patent Office intended to refer to item 7, which corresponds to the rejection of claims 16, 17, 19, and 21 under 35 USC § 103. If this is incorrect, Applicant respectfully requests correction and a new period for response.

To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. (MPEP § 2143.03.) Applicants respectfully submit that the Patent Office has failed to meet its burden of establishing a *prima facie* case of obviousness.

The present invention provides a fluoroelastomer composition comprising a fluoroelastomer blended with a mineral oil. (See claim 16.) The Patent Office acknowledges that Dawes fails to teach a fluoroelastomer blended with a mineral oil, and thus fails to teach all elements of the claimed invention. To correct this deficiency, the Patent Office asserts "it is immaterial whether the fluoroelastomer and mineral [oil] are blended or simply brought into contact with each other . . ." (Paper No. 21, ¶ 6.) This assertion plainly ignores the language of the claim, and Applicant respectfully traverses.

According to MPEP § 2143.03, all words in a claim must be considered in judging the patentability of that claim against the prior art. The Patent Office is not free to selectively disregard claim terms. Independent claim 16 explicitly recites "a fluoroelastomer blended with a mineral oil" (emphasis added); therefore, Applicants respectfully submit that it is improper for the Patent Office to consider this limitation "immaterial."

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In the Office Action dated March 18, 2003, the Patent Office asserted that Dawes discloses that mineral oils can be incorporated into the polymers. (§ 5, citing col. 5, lines 15, 28-32.) Applicant respectfully traverses this characterization of Dawes. At best, Dawes describes including mineral oil in the low molecular weight liquid. (See, col. 5, lines 15, 28-32, emphasis added.) Applicants respectfully submit that the low molecular weight liquid is not the polymeric core material of Dawes, which may comprise a fluoroelastomer (see, col. 3, line 62 – col. 4, line 47); rather, the low molecular weight liquid forms a sheath around the core. (See, e.g., col. 2, line 66 – col. 3, line 9.) In fact, Dawes expressly teaches that “[t]he low viscosity liquid does not become mixed with the polymeric core material under the processing conditions.” (Col. 4, lines 65-67, emphasis added.) Thus, Dawes teaches away from a fluoroelastomer blended with a mineral oil, and therefore fails to describe, teach, or suggest all of the elements of the claimed invention.

In summary, Applicant respectfully submits that the Patent Office has failed to meet its burden in establishing a *prima facie* case of obvious. Specifically, the Patent Office has failed to show how Dawes or the knowledge of one skilled in the art teaches all the elements of the claimed invention. For at least these reasons, the rejection of claim 16 under 35 USC § 103(a) as being unpatentable over Dawes (US 4,485,062) is unwarranted and should be withdrawn.

Claims 17, 19, and 21 each depend from, and add additional features to, claim 16. Claim 16 is patentable for the reasons given above. Thus, claims 17, 19, and 21 are likewise patentable.

For at least these reasons, the rejection of claims 16, 17, 19 and 21 under 35 USC § 103(a) as being unpatentable over Dawes (US 4,485,062) is unwarranted and should be withdrawn.

Claim 20 was not included in the Examiner’s comments despite being listed as rejected in the Office Action Summary. Applicants have treated this claim as within the group 19-21, and it should be patentable with the balance of that group as noted above. If the Examiner intended something different, appropriate correction and a new period for reply are respectfully requested.

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In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested. Allowance of the pending claims at an early date is solicited. If any questions remain that may be addressed during a teleconference, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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